

Appl. No. 09/980,225
Amdt. Dated February 17, 2004
Reply to Office Action of October 23, 2003

• • R E M A R K S / A R G U M E N T S • •

The Advisory Action of January 23, 2004 and the Official Action of October 23, 2003 have been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment the limitations of dependent claim 4 regarding the use of epoxy silane coupling agents and methacryloxy coupling agents have been incorporated into independent claim 1 and dependent claim 4 has accordingly been canceled.

In addition, claim 10 has been changed to be dependent on claim 1.

In addition, dependent claim 7 which recited the same limitations as dependent claim 4 has also been canceled.

Furthermore, non-elected claims 6 and 11-14 have been canceled without prejudice or disclaimer.

Entry of Claim Amendments After Final

The amendments to the claims are believed to be properly enterable after Final Rejection because of several issues.

First, the limitations added to independent claim 1 regarding the use of epoxy silane coupling agents and methacryloxy coupling agents were previously recited in dependent claim 4.

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Accordingly, these limitations are not new limitations in the prosecution.

In addition, in the Advisory Action (in response to applicants' previous amendments to the claims) the Examiner stated: "Furthermore, the listing of coupling agents is indefinite in that it is unclear which agents are to be silanes."

The present amendment to the claims addresses and overcomes the indefiniteness in the claims and is therefore is properly enterable after Final Rejection because it reduces outstanding issues that would go to appeal.

Moreover, in the Advisory Action (in response to applicants' previous amendments to the claims) the Examiner stated: "The amendment raises new issues under 112 in that the claims would be dependent upon canceled claims."

The present amendment to the claims addresses and overcomes this basis of indefiniteness in the claims and is therefore is properly enterable after Final Rejection.

Finally, it is submitted that the amendments to the claims which are presented herein place the application into condition for allowance by limiting the silane coupling agents to epoxy silane coupling agents or methacryloxy silane coupling agents, which were previously recited in claim 4, and for which the Examiner has not been able to find a prior art teaching.

MPEP §803.02 states that:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. (Underlining added)

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Inasmuch as applicants' previous amendments to claim 1 recited a Markush group consisting of vinylic, epoxy or methacryloxy silane coupling agents, it is assumed that the Examiner examined each of these coupling agents individually as required by MPEP §803.02 since the Markush only included 3 members.

Otherwise, if the Examiner did not examine all the three members of applicants' Markush group, the Examiner effectively make a Restriction Requirement without properly advising applicants and without allowing applicants to make a proper election.

Inasmuch as the prior art does not teach epoxy silane coupling agents or methacryloxy coupling agents, it is submitted that the changes presented herein for claim 1 place the application into condition for allowance and are thus proper after Final Rejection.

Moreover, the changes to the claims involve the cancellation of seven dependent claims which reduces the issues that remain under prosecution.

For the reasons set forth above, entry of the changes to the claims is believed to be proper after Final Rejection and accordingly is respectfully requested.

On page 2 of the Official Action the Examiner has taken the position that claims 6 and 11-14 are directed to an invention that is independent or distinct from the invention originally claimed.

The Examiner instituted a Restriction Requirement and took the position that claims 1-5 and 7-10 were constructively elected by prosecution.

Claims 6 and 11-14 were accordingly withdrawn as being directed to a non-elected invention.

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Claims 6 and 11-14 have been canceled herein without prejudice or disclaimer. Applicants reserve their right to prosecute the subject matter of claims 6 and 11-14 by filing and prosecuting one or more divisional applications during the pendency of the present application.

Claims 1, 3-5 and 8-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over European Patent Application No. 0 014 336 to Vaidya.

Claims 1-3, 5 and 9 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,484,844 to Oshima et al. or U.S. Patent No. 5,914,195 to Hori et al.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding rejections of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is respectfully requested.

The Examiner has relied upon Vaidya as showing "chlorinated polyethylene copolymers having the chlorination percent as requisite claim 1."

The Examiner states that "[t]he instantly claimed coupling agent is exemplified at page 8" in Vaidya.

Vaidya fails to teach either an epoxy silane coupling agent or a methacryloxy coupling agent.

Accordingly, Vaidya fails to anticipate applicants' claimed invention.

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Oshima et al. is directed to vinyl chloride resin elastomer compositions which have excellent compression set as "demanded for materials of e.g. glass runs and weather strips."

Hori et al. is directed to thermoplastic resin compositions that are "excellent in creep resistance and bond strength" and which are useful as sealing materials and gaskets.

Neither Oshima et al. nor Hori et al. teach applicants' claimed epoxy silane coupling agents and methacryloxy coupling agents in combination with chlorinated polyethylene, let alone any a composition that would resist blistering when in contact with carbon dioxide.

The Examiner appears to be taking the position that the various prior art references teach compositions that would "inherently" be useful in conjunction with carbon dioxide refrigerants.

As held by the court of appeals in *In re Shetty*:

Inherency is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result.

The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is known. (*In re Shetty*, 195 USPQ 753(CCPA 1977))

In the present case, the use of chlorinated polymer compositions does not lead to the conclusion that the prior art compositions are useful in conjunction with carbon dioxide refrigerants or that all chlorinated polymer compositions can be used to make sealing elements that will effectively seal carbon dioxide.

Inherency cannot be found in the present case where the prior art fails to recognize the use of applicants' claimed molding materials, especially when the claims recite the limitation of a "molding material for use with carbon dioxide refrigerant."

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It is believed that the phrase "for use with carbon dioxide refrigerant" breathes life and meaning into the claims. Note the court of appeals holding in *Loctite Crop.*:

Term in preamble of patent claim breathes life and meaning into the claims and hence is a necessary limitation to them. *Loctite Corp. v. Ultraseal, Ltd.*, 228 USPQ 90, at 92 (CAFC 1985)

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicants' claimed invention.

Moreover, the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

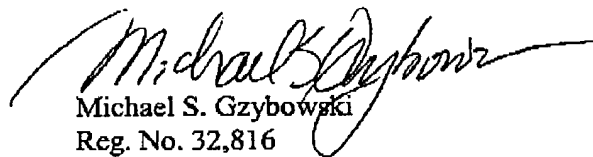
It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

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If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,


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